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EXAMINER

FISCHER, ANDREW J

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/528,693
Filing Date: March 20, 2000
Appellant(s): WRIGHT ET AL.

Michael N. Haynes
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 19, 2005 ("Forth Appeal Brief") appealing from the Office Action mailed June 29, 2005 ("Third Final Office Action").

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The Examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the Forth Appeal Brief is correct.

(4) Status of Amendments After Final

Appellants' statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the Forth Appeal Brief is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Acknowledgements

a) Names or Titles

Unless expressly noted otherwise, all references in this Examiner's Answer to the capitalized versions of "Applicants" or "Appellants" refers specifically the Applicants of record. References to lower case versions of "applicant," "applicants," or "appellant" refers to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" in this Examiner's Answer refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.

b) New Issues on Appeal

The Examiner recognizes that the Board of Patent Appeals and Inferences ("Board") has the power to examine or reexamine patent claims and raise issues sua sponte.

The members of the Board of Appeals are denominated 'examiners-in-chief' in both 35 U.S.C. 3 ('Officers and employees') and 35 U.S.C. [6]. The title chosen by the Congress implies that the members of the board have authority to *examine or reexamine* appealed claims. [Emphasis in original]. *In re Loehr*, 500 F.2d 1390, 1392-93, 183 USPQ 56, 58 (CCPA 1974).

However it also well known that arguments which Appellants could have made but chose not to make in their brief should not be considered by the Board. See 37 C.F.R. §1.192(a) ("Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.").

The Examiner also notes that the Board is titled the “Board of Patent Appeals”¹ and not the ‘Board of Initial Examination.’ By restricting the Board to only *appeals*, the Board’s valuable time is not be wasted. Furthermore, while the Examiner recognizes that due process is an important consideration of the USPTO, Appellants are not pro se and are represented by presumptively competent counsel who could have raised any issue deemed meritorious to their case prior to this appeal.

In light of the above and because the Examiner is not aware of the “good cause” as required by 37 C.F.R. §1.192(a), the Examiner respectfully requests the Board to refrain from addressing issues sua sponte. While the Board clearly has the authority to raise such issues, a decision by the Appellants or the Examiner on whether or not to raise a particular issue is formed only after careful consideration of the extensive administrative record. Other issues may have been contemplated and investigated by Appellants or the Examiner yet not found in the written record because such arguments were considered unsupportive, weak, or tangential to the issues presented herein.

Nevertheless, because the Board continues to address issues sua sponte, an examiner’s only recourse is to anticipate such issues in his or her answer. In this case, the Examiner has tried to address issues that have been brought to the Examiner’s attention in the past by both the Board and other applicants. While this increases the size of the Answer, it is believed to be the only way the Examiner can provide arguments on those issues.

¹ The formal name as stated in 35 U.S.C. §6(a) is the “Board of Patent Appeals and Inferences.”

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c) All Claims Stand or Fall together with Claim 1

With respect to the obviousness rejections, all claims stand or fall together with claim 1.

Applicants argue the obviousness rejection of Cragun in view of Ohanian in section 'G' of their Forth Appeal Brief.

Applicants argue the obviousness rejection of Hudetz in view of Ohanian in section 'H' of their Forth Appeal Brief.

In accordance with 37 C.F.R. §41.36 (vii) and because Applicants have not provided *separate arguments and headings* for the individual claims on appeal, all claims in the obviousness rejection stand or fall with claim 1.

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(9) Evidence Relied Upon by the Examiner

Document ID	Inventor or Author	Date
U.S. Patent No. 5,804,803	Cragun et. al. ("Cragun '803")	September 8, 1998
U.S. Patent No. 5,978,773	Hudetz et. al. ("Hudetz")	November 2, 1999
U.S. Patent No. 6,109,526	Ohanian et. al. ("Ohanian").	August 29, 2000
U.S. Patent No. 6,677,852	Landt	January 13, 2004
How Computers Work	White, Ron	September 22, 1999
How the Internet Works	Gralla, Preston	September 23, 1999
Applicants' "Second Williams Declaration" is Found in their Forth Appeal Brief – Appendix C		

Table 1 – Evidence Relied Upon by the Examiner

(10) Grounds of Rejection

The following two (2) grounds of rejection are applicable to the appealed claims:

(1) Claims 1-6 are rejected under 35 U.S.C. §103(a) as being unpatentable over Cragun '803 in view of Ohanian.

(2) Claims 1-6 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Hudetz in view of Ohanian.

Because “[i]t is well settled that ‘anticipation is the epitome of obviousness,’” *In re McDaniel*, 293 F.3d 1379, 1385, 63 USPQ2d 1462 (Fed. Cir. 2002) citing *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983) and quoting *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 69, 571 (CCPA 1982); because the references used in the anticipation rejections in the Third Final Office Action are also the primary references used in the obviousness rejections; and in an effort to simplify issues on appeal; except for the two (2) obviousness rejections noted above, the Examiner hereby withdraws all other rejections. To be especially clear, all rejections based upon 35 U.S.C. §102 and 35 U.S.C. §112 2nd paragraph are withdrawn. Thus, this appeal involves only two (2) rejections based upon 35 U.S.C. §103(a).

(10) Response to Argument

Summary of the Examiner's Arguments

1. First and for purposes of the applying the prior art, it makes no difference what so ever whether Board uses the Examiner's definition for 'programmable logic controller' or Applicants' definition for 'programmable logic controller.' Because it makes no difference, the Examiner will use Applicants' definition for 'programmable logic controller' when applying the prior art.
2. Because Applicants' lexicographic definition the Second Williams Declaration is considered new matter, it is not controlling.
3. Nevertheless, in order to simply this appeal, and for purposes of applying the prior art in the two obviousness rejections,

**the Examiner will use Applicants' definition of 'PLC' as found
Appendix C in Applicants' Forth Appeal Brief, page 4, Paragraph No. 18.**

4. The Examiner will then show even using Applicants' definition, the claims are obvious.
5. Additionally, the Examiner will show why Applicants' definition of 'programmable logic controller' in the Second Williams declaration is new matter.

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6. Finally, the Examiner notes the following from the Third Final Office Action, page 7, Paragraph No. 19:

Moreover, it is the Examiner's factual determination that bar code tags and radio frequency ("RF") tags are art recognized equivalents. See MPEP §2144.06. Both bar code tags and RF tags are used for the same purpose: conveying information about the article to which the tags are attached to a reader machine. Additionally, one of ordinary skill in the art recognizes that the selection of either a bar code tag over an RF tag (or vice versa, RF tag over a bar code tag) is not enough to distinguish the claimed invention over the prior art since both devices are recognized as interchangeable depending upon their intended use or the particular environment in which the tag will be used. See MPEP §2144.07. Evidence to support these conclusions includes but is not limited to Rakers et. al. (U.S. 6,763,996 B2); Keys et. al. (U.S. 6,758,403 B1); Monico (U.S. 6,557,758 B1); McAllister (U.S. 6,415,978 B1); Helton et. al. (U.S. 6,357,662 B1); Maloney (U.S. 6,232,876 B1); Wurtz et. al. (U.S. 5,838,253); Rupport et. al. (U.S. 5,640,002); Kewin (U.S. 5,595,356); Eberhardt (U.S. 5,28,784); and Scribner et. al. (U.S. 4,688,026).

First Obviousness Rejection

- (1) Claims 1-6 are rejected under 35 U.S.C. §103(a) as being unpatentable over Cragun

'803 in view of Ohanian. The Third Final Office Action stated:

Claims 1-6, as understood by the Examiner, are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Cragun '803 in view of Ohanian et. al. (U.S. 6,109,526) ("Ohanian"). . . . , Ohanian directly teaches the use of RF tags in replace of bar codes because, inter alia, bar codes may be obscured.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cragun '803 as taught by Ohanian to include RF tags in replace of bar codes. Such a modification would have helped get the data more quickly if the bar codes became obscured and would have allowed the tags to be reused because they electronically rewritten with data thereby overcoming the permanency of barcode symbols.

7. Cragun '803 discloses a product information apparatus comprising an indicator (radio frequency tag having code 117, translation program 110, and URL output; the bar code is a machine readable form of the URL) associated with a product and embedded in a memory (in the

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magnetic encoded with the radio frequency tag); a web page (document 174) indicated by the indicator (via the URL); the indicator directs the web page to product information (inherent) where the information is provided to the user (via display screen 114); wherein the indicator is specific to each product (tangible object 115) such that a plurality of indicators are needed to find out information about a plurality of products; the indicator (at least the bar code part) is disposed on the label which is on the object (tangible object 115 in Figure 1A); memory (106); means for automatically interfacing with the Internet to access the web page (120 and 121); and the memory is a micro-chip (inherent in radio frequency tag).

8. Additionally Cragun '803 directly states in column 12, lines 6-10 the following:

“Other technologies, such as magnetic encoding or **radio frequency tags** could also be used. [Emphasis added.]”

Alternative Embodiments

9. Thus, Cragun '803 directly shows in an alternative embodiment where instead of a bar code, radio frequency tags are used. It is the Examiner's position that its common sense that one of ordinary skill in the art knows that radio frequency tags must have a memory. For an exemplary RF tag. See Landt (U.S. 6,677,852 B1), Figure 2A.

Product information Help Window

10. Cragun '803 discloses using the operating system "Windows." See Cragun '803, C5, lines 3-4. Cragun '803 also discloses displaying help information

[S]uch as price, size, weight, expiration date, nutritional information, instructions for use, product applications, warranty, warnings, rating by independent testing organizations, product demonstrations or samples, service information, and background, biographical or historical information about the creator, service provider, manufacturer, or seller.

11. Thus Cragun '803 directly discloses displaying this help information in a window. In fact, everything displayed is in a window BECAUSE THE OPERATING SYSTEM IS 'WINDOWS.'

Does Not Expressly Recite 'Memory'

12. Because Cragun '803 does not expressly recite the term "memory," the Examiner relies on Ohanian and its direct disclosure of how "RF tags may be electronically rewritten with data" Ohanian, C1, L34-36. In fact, Ohanian also directly states:

One disadvantage of bar code symbols is that they may not be altered once printed. For example, if a bar code symbol encodes information about objects contained within a box, and then one of the objects is removed from the box, the bar code symbol may not be updated. Instead, a new bar code symbol must be printed and affixed to the box. Another disadvantage of bar code symbols is that they typically must be visible to the scanner or imager. If they are obscured (e.g., within a box), the scanner/imager may not read the symbol.

Radio frequency (RF) tags overcome these limitations of bar code symbols. Certain RF tags may be electronically rewritten with data, thereby overcoming the permanency of bar code symbols. Additionally, RF tags may be interrogated or polled through opaque surfaces, such as through boxes, to exchange data therewith. Ohanian C1, L20-37.

13. Thus radio frequency tags must have a memory.

Programmable Logic Controller is an RFID Tag

14. Even using Applicants' definition of 'PLC' as found Appendix C in Applicants' Forth Appeal Brief, page 4, Paragraph No. 18, that definition is a PLC. Again, see Landt (U.S. 6,677,852 B1), Figure 2A for a typical RFID tag. In particular Applicants state that a PLC is

[A] digitally operating electronic apparatus which uses a programmable memory for the internal storage of instructions for implementing specific functions such as logic, sequencing, timing, counting and arithmetic to control through digital or analog input/output modules, various types of machines or processes.

15. Again, a RFID tag is a PLC. See again Figure 2A in Landt. In particular this RFID tag is a digitally operating electronic apparatus which uses a programmable memory 206 for the internal storage of instructions for implementing specific functions such as logic 204. Additionally, the RFID tag controls the process of identifying the particular item to which it is attached. Thus, an RFID tag is a PLC.

RFID is Coupleable to the Internet and the Product

16. It is not disputed that the RFID tag (which is attached to an object) is coupleable to the Internet so that the URL stored within can access and retrieve the web page with the stored information.

Second Obviousness Rejection

17. Claims 1-6 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hudetz in view of Ohanian.

18. Like Cragun '803, Hudetz directly discloses in column 12, lines ~ 17-21 the following: "Alternatively, a RF data collection scanner or CCD scanning system could be used." Thus, Hudetz uses in an alternative embodiment an RFID tag and a RFID collection scanner.

19. Hudetz in view of Ohanian renders claim 1 obvious.

Response to Applicants' Particular Obviousness Argument of Cragun '803 in view of Ohanian

20. First, Applicants argue in Section 'G' on page 16 that the Examiner must use Applicants' definition of PLC. For purposes of applying the prior art noted above, the Examiner used the definition of PLC as noted in the Second Williams declaration. This argument is therefore moot.

21. Next Applicants' argue that Cragun '803 does not disclose an online product support help window. The Examiner disagrees since the operating system is 'Windows' and because Cragun '803 directly discloses displaying helpful information such as price, size, weight, expiration date, nutritional information, instructions for use, product applications, warranty, warnings, rating by independent testing organizations, product demonstrations or samples, service information, and background, biographical or historical information about the creator, service provider, manufacturer, or seller. Thus, when this information is displayed, its in an online product support help window.

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22. Applicants' remaining arguments in section G have been considered but are not persuasive because these arguments simply do not make sense.

23. For this reason alone, the obviousness rejection of claims 1-6 should be sustained.

Response to Applicants' Particular Obviousness Argument of Hudetz in view of Ohanian

24. First, Applicants argue in Section 'H' on page 17 that the Examiner must use Applicants' definition of PLC. Again and for purposes of applying the prior art noted above, the Examiner used the definition of PLC as noted in the Second Williams declaration. This argument is therefore moot.

25. Second Applicants arguments regarding "wireless data receiver" do not make sense. TO be clear: THE EXAMINER IS NOT RELYING ON OHANIAN'S WIRELESS RECEIVER. Applicants argument is simply not understood.

26. Applicants next argues that there "would have been no motivation to suggest or modify or combine the applied references" ² Are Applicants serious? Have they actually even READ Ohanian? To be clear, Applicants challenge the motivation to replace bar codes with RFID? AGAIN and as noted previously, Ohanian, C1, L34-36 directly states:

One disadvantage of bar code symbols is that they may not be altered once printed. For example, if a bar code symbol encodes information about objects contained within a box, and then one of the objects is removed from the box, the bar code symbol may not be updated. Instead, a new bar code symbol must be printed and affixed to the box. Another disadvantage of bar code symbols is that they typically must be visible to the scanner or imager. If they are obscured (e.g., within a box), the scanner/imager may not read the symbol.

Radio frequency (RF) tags overcome these limitations of bar code symbols. Certain RF tags may be electronically rewritten with data, thereby overcoming the permanency of bar code symbols. Additionally, RF tags may be interrogated or polled through opaque surfaces, such as through boxes, to exchange data therewith. Ohanian C1, L20-37.

27. Applicants arguments are therefore not persuasive.

² Applicants' Forth Appeal Brief, page 18, ~ lines 12-16.

Lexicography

28. Because the Examiner has used Applicants' definition of PLC, for purposes of this appeal, Applicants' lexicography arguments are moot.

29. In the event the Board does not sustain the obviousness rejections, Applicants' lexicographic definition as found in the Second Williams declaration is considered new matter.

30. It is important to note that Applicant is arguing lexicography and not the 'broadest reasonable interpretation.' This makes sense from Applicants' viewpoint because under the broadest reasonable interpretation, the Examiner is not bound by Applicants definition of a claim term. "Absent an express definition in their specification [*i.e.* lexicography], the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO's definition unreasonable when the PTO can point to other sources that support its interpretation." *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997).

Claim Terms are Fixed Upon Filing

31. First, all claim terms—both lexicographic and non-lexicographic terms—are fixed upon filing. See *PC Connector Solutions LLC v. SmartDisk Corp.*, 406 F.3d 1359, 1363, 74 USPQ2d 1698, 1700 (Fed. Cir. 2005) ("A claim cannot have different meanings at different times; its meaning must be interpreted as of its effective filing date."); *Middleton Inc. v. Minnesota Mining and Manufacturing Co.*, 311 F.3d 1384, 1389, 65 USPQ2d 1138, 1142 (Fed. Cir. 2002) ("The meaning of a patent term, however, is not subject to revision The meaning of patent terms depends on the usage of those terms in context by one of skill in the art *at the time of application*. [Emphasis added.]"); *Wiener v. NEC Elecs., Inc.*, 102 F.3d 534, 539, 41 USPQ2d

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1023, 1027 (Fed. Cir. 1996) (“Ultimately, a court must construe the claim language according to the standard of what those words would have meant to one skilled in the art *as of the application date*. [Emphasis added.]”)(overruled on other grounds in *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454-55, 46 USPQ2d 1169, 1173 (Fed. Cir. 1998) (en banc)); *Plant Genetic Systems N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1345, 65 USPQ2d 1452, 1460 (Fed. Cir. 2003)(“We hold that the district court did not ignore the plain meaning of the claims, but properly gave objective meaning to them as they were understood *at the time the patent application was filed*. [Emphasis added.]”); and *Kopykake Enterprises Inc. v. Lucks Co.*, 264 F3d 1377, 1383, 60 USPQ2d 1124, 1127 (Fed. Cir. 2001) (“[W]hen a claim term understood to have a narrow meaning when the application is filed later acquires a broader definition, the literal scope of the term is limited to what it was understood to mean at the time of filing.”). So once an applicant files his or her specification, the meaning of *all* claim terms—both lexicographic and non-lexicographic—are fixed.

32. Because claim terminology is fixed upon filing, if an objective review of the specification reveals that the applicant has redefined a claim term using lexicography, the applicant is bound by that definition. The applicant can not subsequently change or modify that lexicographic definition. See *e.g. In re Bass*, 314 F.3d at 577-78, 65 USPQ2d at 1158 (noting that “Bass chose to define ‘motorized sports boat’ in the specification. He cannot change or modify that definition on appeal.”).

33. The converse is equally true. As of the effective filing date, if an objective review of the specification reveals that the applicant has *not* redefined a claim term using lexicography with

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the required clarity, deliberateness, and precision,³ even if the applicant harbored a subjective intent to do so, lexicography cannot be invoked. See *e.g. In re Thrift*, 298, F.3d 1357, 1364, 63, USPQ2d 2002, 2006 (Fed. Cir. 2002) (“Although an applicant may be his own lexicographer, nothing in the *specification* defines the phrase ‘speech user agent’ differently from its ordinary meaning. [Emphasis added.]”) (citations omitted).⁴

Lexicographic Definition Must be in the Specification

34. Moreover and as noted in *In re Thrift* above, the lexicographic definition must be in the specification, NOT A DECLARATION SUBMITTED AFTER THE FILING DATE. See *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 21 USPQ2d 1383 (Fed. Cir. 1992) noting that for lexicography, “the place to do so is in the specification” *Intellicall*, 952 F.2d at 1388, 21 USPQ2d at 1386.

35. Therefore because the specification is silent as to what is a PLC, Applicants’ definition of programmable logic controller as submitted in the Second Williams Declaration is new matter.

³ “The patentee’s lexicography must, of course, appear ‘with reasonable clarity, deliberateness, and precision’ before it can affect the claim.” *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

⁴ See also *Process Control Corp. v. Hydrex Corp.*, 190 F.3d 1350, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999)(noting that “[w]hile we have held many times that a patentee can act as his own lexicographer to specifically define terms of a claim contrary to their ordinary meaning, the quoted portions from the written description above do not so clearly redefine ‘the discharge rate’ . . . so as to put a reasonable competitor or one reasonably skilled in the art on notice that the patentee intended to so redefine that claim term.”); *Abbott Labs. v. Baxter Pharm. Prods.*, 67 USPQ2d 1191, 1194 (Fed. Cir. 2003)(“Because the patentee did not deviate from the accustomed meaning of the disputed claim term, the term ‘effective amount’ is construed in view of its ordinary and customary meaning.”).

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.


For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

A. J. Fischer 1/23/06

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